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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,878	05/30/2001	Vance M. Stephens	10003568-1	8982

7590 10/26/2006  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER	
SCHLACK, SCOTT A	
ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/870,878	<b>Applicant(s)</b> STEPHENS, VANCE M.	
	<b>Examiner</b> Scott A. Schlack	<b>Art Unit</b> 2625	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 03 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-4, 6-14 and 16-21.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

  
**KIMBERLY WILLIAMS**  
 SUPERVISORY PATENT EXAMINER

(CAW)

Continuation of 11, does NOT place the application in condition for allowance because: The claim language to which the applicant bases their arguments is ~~vague~~ and does not clearly specify what the applicant alleges, according to the examiners claim interpretation. The examiner views the cited references to meet the claimed limitations as cited in the Response to Arguments section of the response to the after-final amendment.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's after-final amendment was received on 10/03/2006, and has been entered and made of record. Currently, claims **1-4, 6-14** and **16-21** are pending.

### ***Response to Arguments***

2. Applicant's after-final arguments have been fully considered but they are not persuasive.

3. Specifically, the applicant argues that the 35 U.S.C. 103(a) rejection of Ohsumi et al. (US 6,052,552) in view of Kato (US 6,799,761) does not meet the amended printing method feature of determining actual medium size and/or medium placement characteristics, said actual medium size characteristics including an actual medium length along the medium feed path.

***Examiners Response:*** The examiner views the Ohsumi in view of Kato combination to meet said feature and notes to the applicant that the claims in question are vague and lack sufficient descriptive language as to specify what the applicant argues is lacking in said prior art combination. For example the applicant might want to use terminology such as "calculating" and "measured" to replace the vague wording "determining" and "actual" in the claims.

As a basis for this suggestion, the examiner cites section 2111 [R-1] of the Manual for Patent Examining Procedure, *Claim Interpretation; Broadest Reasonable Interpretation*, CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION. During patent examination, the pending claims must be "given their

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broadest reasonable interpretation consistent with the specification.” In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the 35 U.S.C. 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the

words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.").

Therefore, the examiners reasoning in the previous office action dated 08/04/2006, is maintained and viewed to cover the vague claim language.

4. Regarding claims 1 and dependent claims 2-4 and 6-10, which have all been amended to contain the contents of claim 5: The applicant argues the 35 U.S.C 103(a) rejection of Ohsumi et al. in view of Kato, by stating that "The examiner asserts that Kato discloses in column 5, lines 61-67 and column 6, lines 1-12 that 'information relating to the length of the sheet is detected'.", further the applicant argues that, "The cited passage of Kato does not describe that information relating to the length of the sheet is detected..."

The examiner notes that in the office action dated 02/10/2006 relating to the 35 U.S.C 103(a) rejection of Ohsumi et al. in view of Kato, examiner Rahimi correctly asserts that Kato discloses that information relating to the length of the sheet is detected in col 5, lines 61-67 and col 6, lines 1-12. Kato discloses, "The CPU determines the timing of the stop or the reversal of the large-diameter roller 25 according to the detection signal from the sheet detection means 27a or 27b and information relating to the length of the sheet in the conveying directions input from an operation unit (not shown)." The examiner interprets this to be equivalent to determining medium size pertaining to the actual medium length of the sheet along the media feed path (seen in Fig 2 of Kato). The examiner further interprets the CPU to determine the

actual length of the medium by means of the user input. For example if the user, supplying the user input to the CPU, determines the actual length to be 11 inches (along the direction of the media feed path) in a 8.5x11 inch piece of printing paper or medium, the CPU then determines the actual length from the user input. *Further, as another example, the user is capable entering the actual length of paper, which may vary from the nominal size.*

Therefore, the examiner interprets the reference to correctly read on the claimed features.

5. Regarding claim **7-8**: The applicant argues the 35 U.S.C 103(a) rejection of Ohsumi et al. in view of Mizubata et al. on the grounds that the Mizubata et al. is not directed towards a method for printing and is therefore not properly combinable with the teachings of Ohsumi as asserted by examiner Rahimi.

The examiner notes that examiner Rahimi correctly asserts the like field of endeavor as being Image-Forming apparatuses and Means to Correct for Skewness. This is viewed to be a proper like field of endeavor for the obviousness combination.

6. Regarding claim **11** and its respective dependent claims **12-14** and **16-21**, which have all been amended to contain the contents of claim **15**: The applicant argues that the Ohsumi et al. in view of Wibbels et al. combination and examiner Rahimi's obviousness claim, by stating that, "the examiner has made only broad, conclusory statements regarding the teachings of the references, and has asserted a broad statement of an alleged motivation to combine, i.e. to 'reproduce the original in the same exact layout.' Yet there is no description as to how the references provide this

alleged suggestion, or indeed how the alleged suggestion would lead one to the claimed subject matter”.

The examiner views Wibbles et al. to sufficiently disclose the method of alignment, *as claimed*, in column 5, lines 1-15, and further views both examiner Rahimi's obviousness statement and motivational statement for combination to be sufficient. Also, the examiner notes that the newly amended content of claim 15 with claim 11 warrants the 35 U.S.C. 103(a) rejection of Ohsumi et al. in view of Wibbels et al. in further view of Kato. Also, for similar reasons as stated above in claim 1 combined with claim 5, the newly amended content from claim 15 is viewed by the examiner to be sufficiently met by the Kato combination.

7. Arguments posed for claims **17-18** are similar to those disclosed above for claims **7-8**. Therefore, the examiner's responses for claims **7-8**, also hold for claims **17-18**.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Schlack whose telephone number is 571-272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for




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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Note to the applicant:** Art Unit 2624 has been redesignated as Art Unit 2625 due to organizational restructuring with the USPTO.



Scott A. Schlack